

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Attorney Docket No. 13315US02

In the Application of:)	
Christopher Pasqualino)	Electronically Filed
)	
U.S. Serial No.: 10/034,414)	February 7, 2011
)	
Filed: December 27, 2001)	
)	
)	
Examiner: Phillippe, Gims)	
)	
Group Art Unit: 2482)	
)	
Confirmation: 1160)	
)	

REPLY BRIEF

Mail Stop Appeal Brief – Patents
Commissioner for Patents
P.O. Box 1450
Alexandria VA 22313-1450

Sir:

This Reply Brief is in response to the Examiner's Answer mailed December 7, 2010.

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I. REAL PARTY IN INTEREST

Broadcom Corporation, a corporation organized under the laws of the state of California and having a place of business at 16215 Alton Parkway, Irvine California 92618-3616, has acquired the entire right, title, and interest in and to the invention, the application, and any and all patents to be obtained therefore, as set forth in the Assignment filed with the present application and recorded on 2/20/2002 at Reel/Frame 012614/0045.

II. RELATED APPEALS AND INTERFERENCES

There are no related appeals or interferences with this case.

III. STATUS OF THE CLAIMS

Claims 1-18 were cancelled.

Claims 19-21 were rejected under 35 U.S.C. § 103(a) as being obvious from Mair.

The rejection to claims 19-21 are appealed.

IV. STATUS OF AMENDMENTS

There are no amendments pending in the present application.

V. SUMMARY OF CLAIMED SUBJECT MATTER

Features of the present invention may be found in a video encoding scheme supporting the transport of audio and auxiliary information.

Claim 19 is directed to a system for transmitting auxiliary data in video encoding. The system comprises an un-enhanced encoder, an enhanced encoder; an un-enhanced decoder, and an enhanced decoder. The un-enhanced decoder is adapted to communicate with said un-enhanced and enhanced encoders. The enhanced decoder is adapted to communicate with said un-enhanced and enhanced encoders.

Claim 19 is described in the specification for example a system for transmitting auxiliary data in video encoding comprising an un-enhanced encoder, an enhanced encoder; an un-enhanced decoder, and an enhanced decoder is described in the Specification, p. 4-8, Figure 1, (Un-Enhanced Encoder 101, Enhanced Encoder 111, Un-Enhanced Decoder 107, Enhanced Decoder 105). The un-enhanced decoder is adapted to communicate with said un-enhanced and enhanced encoders. Page 5, Lines 11-15; Figure 1, Un-Enhanced Decoder 107. The enhanced decoder is adapted to communicate with said un-enhanced and enhanced encoders. Page 5, Lines 11-15; Figure 1, Enhanced Decoder 105.

VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

Appellant respectfully requests that the Board review the rejection of:

Claims 19-21 under 35 U.S.C. § 103(a) as obvious from Mair.

VII. RESPONSE TO EXAMINER'S ANSWER TO CLAIM 19

Claim 19 is copied below:

A system for transmitting auxiliary data in video encoding comprising:

an un-enhanced encoder;

an enhanced encoder;

an un-enhanced decoder adapted to communicate with said un-enhanced and enhanced encoders; and

an enhanced decoder adapted to communicate with said un-enhanced and enhanced encoders.

The issue on appeal is best understood by the following hypothetical. IF, *arguendo*:

(1) A provisional application is filed first by another party. The provisional application provides support as defined in 35 U.S.C. 112 for subject matter A but not subject matter B;

(2) Applicant files a provisional patent application after (1), providing support for subject matter B;

(3) The another party files a published utility patent application that claims priority to (1) after (2). The utility patent application claims subject matter A and provides support for subject matter B;

(4) Applicant files a utility patent application claiming priority to (2) and claims subject matter B.

ISSUE: Can the application in (3) be prior art against subject matter B application in (4)?

Examiner's position, as best understood, in the answer appears to be:

Since the provisional application properly supported subject matter A that was claimed in the utility patent application, it is prior art.

Appellant's position is:

it cannot be prior art against be used as prior art against the claimed subject matter B in (4).

From Examiner's Answer, this is believed to be a fair representation of Examiner's position. The Answer goes through considerable lengths to establish teachings of "the DVI signal perform the encoding while two additional bits perform specific and distinct functions", "a DVI encoding an 8B/10B encoding where auxiliar data perform specific function and distinct function." Neither of the foregoing are claim limitations. Answer at 7. Furthermore, the Answer at 8 notes that "Examiner used the disclosure of US Patent Application Publication to Mair to show where the limitations are met. The Appellant's arguments are not directed to the Publication, but the '924 provisional application."

Additionally, Examiner has indicated "Considering the fact that the elements of the Abstract of Mair's Publication (2002/0186322 A1) are found in the proposal (which is the provisional application) it is clear to the examiner that one skilled in the art can and would look to the provisional application to derive the Abstract as well as to find the claimed limitations of the applicant." Final Office Action at 3.

Appellant reiterates that Examiner's position is in error because it is contrary to MPEP 2136.03 (The 35 U.S.C. 102(e) critical reference date ... is the filing date of the provisional application with certain exceptions if the provisional application(s) properly supports the subject matter relied upon to make the rejection in compliance with 35 U.S.C. 112, first paragraph.”).

Contrary to Examiner's Answer at 7, that “appellant never presented an argument with respect to the merits of the claim”, Appellant pointed out numerous citations relied upon by Examiner in Mair, utility patent publication that were not supported in the provisional application. See Appeal Brief at 6-7 (0033, 0035, 0042, 0043, Figures 2 and 5). Examiner's response “While provisional application '924 does not provides any drawings, each section of the proposal provides a summary of the actual Patent Application used to meet the limitations”.

Examiner's response is simply conclusory. For example, although arguing “each section of the proposal provides a summary of the actual Patent Application used to meet the limitations”, the Answer does not which section of the proposal is believed to support which part of the Patent Application used to meet the limitations as is required by MPEP 2136.03.

For example, Examiner states that “Mair provides the encoding and decoding in figs. 3A, 3B and 5...”. See Answer at 4. Mair, publication Figures 3A and 3B are copied:

application] provides a summary of the actual Patent Application used to meet the limitations” should be required.

Finally, Appellant respectfully submits that Appellant’s position is also supported by logic. Suppose party A conceives of an invention first, and promptly files an application for patent. Suppose party B conceives of the invention later. However, B has a previously filed provisional patent application that is unrelated to the invention. If party B files a utility patent application claiming the subject matter of the provisional and including the invention conceived first by A and then by B, under Examiner’s position, party B could anticipate party A’s claim to the invention, *even though party A was the first to conceive*.

However, under Appellant’s position, party B should only be entitled to the priority filing date for inventions disclosed in the provisional patent application, but should not would not be entitled to the filing date under 35 U.S.C. 102(e) for A’s invention.

For the foregoing reasons, Appellant respectfully requests that the Board REVERSE the rejection to claim 19 and dependent claims 20 and 21.

VIII. CONCLUSION

For the foregoing reasons, all of the pending claims are distinguishable over the prior art of record. Reversal of the Examiner's rejection and issuance of a patent on the application are therefore requested.

The Commissioner is hereby authorized to charge the the Appeal Brief fee and any additional fees or credit any overpayment to the deposit account of McAndrews, Held & Malloy, Account No. 13-0017.

Respectfully submitted,



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Dated: February 7, 2011

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CLAIMS APPENDIX

1-18. (Cancelled)

19. (Previously Presented) A system for transmitting auxiliary data in video encoding comprising:

an un-enhanced encoder;

an enhanced encoder;

an un-enhanced decoder adapted to communicate with said un-enhanced and enhanced encoders; and

an enhanced decoder adapted to communicate with said un-enhanced and enhanced encoders.

20. (Previously Presented) The system of Claim 19, wherein said enhanced decoder is adapted to communicate enhanced data word.

21. (Previously Presented) The system of Claim 19, wherein said un-enhanced encoder is adapted to communicate un-enhanced data word.

EVIDENCE APPENDIX

(None)

RELATED PROCEEDINGS APPENDIX

(None).